

REMARKS

Claims 1-4 and 6-25 are currently pending.

I. Claim 9

The First Office Action listed claim 9 in a §103 rejection. However, in the Final Office Action dated February 7, 2007 the Examiner does not list claim 9 in a statement of a rejection.

Applicants request clarification of the status of claim 9.

II. The Rejections Based on Verrall (US 6,099,758)

Claims 1-4, 7-8, 11, 12 and 24 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Verrall (US 6,099,758).

Claim 10 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verrall and further in view of Cobb (US 6,515,785).

Claim 13 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verrall and further in view of Ouderkirk (US 6,573,963).

Claim 14 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verrall in view of Ouderkirk and as evidenced by Kameyama (US 6,088,079).

Claim 15 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verrall in view of Ouderkirk and further in view of Kashima (US 6,961,106).

Claim 16 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verrall in view of Ouderkirk and further in view of Taber (US 5,731,886).

Claim 17 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verrall in view of Ouderkirk and further in view of Kawata (US 5,518,783).

Claim 18 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verrall in view of Ouderkirk and further in view of Duncan (US 6,175,400).

Claim 19 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verrall in view of Ouderkirk and further in view of Sakatani (Abstract, JP 06-082777).

Claims 20-23 and 25 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verrall and further in view of Kameyama (US 6,088,079).

The Examiner's positions for each of the rejections are basically the same as set forth in the First Office Action.

In the "Response to Arguments", paragraphs 13-16 of the Final Office Action, the Examiner notes that Applicants argue that the photoisomerizable material (c) is not a polymerizable material, and that therefore, the stilbene and azobenzene type compounds do not have a polymerizable functional group. In response, the Examiner states that Applicant's specification discloses that any of the compounds causing a photoisomerization reaction can be employed without any specific limitation thereon (page 21, lines 3-5) and that Applicants fail to limit the photoisomerizable material (c) to one that is not a polymerizable material and does not have a polymerizable functional group. The Examiner also notes that the features upon which applicant relies (i.e., does not have a polymerizable functional group) are not recited in the rejected claims.

Applicants respectfully submit that the present invention is not anticipated by or obvious over the disclosures of Verrall, alone or in view of the secondary references, and request that the Examiner reconsider and withdraw these rejections in view of the following remarks.

In the Amendment filed November 6, 2006, Applicants amended claim 1 to include a portion of the subject matter of claim 5. Applicants' claim 5 originally recited "wherein the photoisomerizable material (c) is at least one kind selected from the group consisting of stilbene, azobenzene and a derivative thereof". Similarly, Applicants' specification, page 21, lines 9-11, recites "[a]s a photoisomerizable material, among them, it is preferable to use at least one kind selected from the group consisting of stilbene, azobenzene and derivatives thereof." It is also noted that Applicants use the singular term "stilbene" and "azobenzene."

While it may be argued that a derivative of a stilbene compound and a derivative of an azobenzene compound may be include a polymerizable group, a stilbene compound and an azobenzene compound do not include a polymerizable group.

In view of the language of Applicants' specification and claims, Applicants' definition of stilbene and Applicants' definition of azobenzene do not include derivatives of stilbene and derivatives of azobenzene. That is, Applicants separately define separately the compound stilbene, the compound azobenzene, derivatives of stilbene and derivatives of azobenzene.

While Applicants' terms stilbene and azobenzene do not include derivatives of stilbene and derivatives of azobenzene, Applicants' claims have been amended more directly clarify the meaning of the terms stilbene and azobenzene.

When an Applicant has disclosed a broad group of compounds, Applicant can limit the claims to a narrower group of compounds. The Court has held that:

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

In re Johnson and Farnham, 194 USPQ 187, 196 (CCPA 1977).

Applicants have amended to claims to exclude from the photoisomerizable material the polymerizable compounds of the references of the rejections.

For the above reasons, it is respectfully submitted that the subject matter of claims 1-4 and 6-25 is neither taught by nor made obvious from the disclosures of Verrall, alone or in view of the secondary references, and it is requested that the rejections under 35 U.S.C. §§102 and 103 be reconsidered and withdrawn.

III. Conclusion

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the objection to the claims, the rejections under 35 U.S.C. §§102 and 103 and the obviousness-type double patenting rejection be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

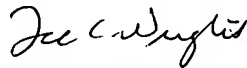
Amendment
Application No. 10/542,017

Attorney Docket No. 052738

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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